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DOCKET USG-3368

CPA/1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Anticipated Classification of this application:

Class 106 Subclass

Application No.: 09/716,392
Examiner: CALLIE E. SHOSHO
Unit Art: 1714

PRIOR APPLICATION

BOX CPA
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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**CONTINUED PROSECUTION APPLICATION (CPA) TRANSMITTAL (Formerly FWC)
(C.F.R. 1.53(d))**

WARNING: This form cannot be used where the parent case may not be abandoned because the filing of a request under the CPA procedure "is a request to expressly abandon the prior application as of the filing date of the request for an application under [37 C.F.R. 1.53(d)]." 37 C.F.R. 1.53(d)(2)(v).

WARNING: Filing under 37 C.F.R. 1.53(d) is permitted only if filed by the same or less than all the inventors named in the prior application. 37 C.F.R. 1.53(d).

CERTIFICATION UNDER 37 C.F.R. 1.10
(Express Mail label number is mandatory.)
(Express Mail certification is optional.)

I hereby certify that this CPA Transmittal and the documents referred to as attached therein are being deposited with the United States Postal Service on March 14, 2003, in an envelope as "Express Mail" (ER 079636357 US) addressed to: BOX CPA, Assistant Commissioner for Patents, Washington, D.C. 20231.

Donald E. Egan

(type or print name of person mailing paper)

Donald E. Egan
Signature of person mailing paper

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission-on date for this correspondence. Facsimile procedures of 37 C.F.R. 1.8 apply to receive a receipt date.

WARNING: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Cor. 24, 1996, 60 Fed. Reg. 56,439 at 56,442.

WARNING: No copy of the prior application or new specification is required, "Any new specification filed with the request for an application under [1.53(b)] will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with Sec. 1.125." 37 C.F.R. 1.53(d)(5).

WARNING: Continued Prosecution Application procedure filings can only be based on a prior complete application as defined by § 1.51(b), and not a prior complete provisional application as defined by § 1.51(c).

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750.00 DP

not the same. A 37 C.F.R.
1.48 petition to correct
inventorship is also
submitted.

- ☒ This is a request for a filing under the continued prosecution procedure (37 C.F.R. 1.53(d))
for a
- ☒ continuation
- ☐ divisional
- ☐ continuing application to permit consideration of an information disclosure statement under 37 C.F.R. 1.97.

Note: See 37 C.F.R. 1.53 (d)(2) for definition of filing date. The prior nonprovisional application under 37 C.F.R. 1.53(d) must be complete as defined in 37 C.F.R. 1.53 (d)(1)(I).

PARTICULARS OF PRIOR NONPROVISIONAL APPLICATION

WARNING: Continued Prosecution Application filings can only be based on a prior complete application as defined by §1.51(b) or 35 U.S.C. 371, and not a prior complete provisional application as defined by §1.52(c). 37 C.F.R. 1.53(d).

- A. **Application NO.:** 09/716,392, filed: NOVEMBER 20, 2000
- B. **Title:** ABUSE RESISTANT SKIM COATING COMPOSITION (as originally filed and as last amended)
- A. **Names of applicant(s):** THOMAS G. HOUMAN, RICHARD B. STEVENS, THERESA A. FULTS and TIMOTHY G. KENNY (as originally filed and as last amended)
- D. **Addresses:** 3327 N. Oleander, Chicago, IL 60634; 493 Hampshire, Crystal Lake, IL 60014; 471 Elmhurst, Woodale, IL 60191; and 525 Meadow Lane, Libertyville, IL 60048, respectively.
- E. Please use all the contents of the prior application including the drawings, as the basic papers for the new application. It is understood that secrecy under 35 U.S.C. 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 C.F.R. 1.53(d) application, be it another this application or a prior application in the same file wrapper, the PTO may provide similar information or access to all the other applications in the same file wrapper.

I. Inventorship statement

NOTE: An application filed under [1.53(d)] may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under [1.53(d)] when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of petition under §1.48. 37C.F.R. 1.53(d)(4).

- ☒ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are:
- ☒ the same.
- ☐ less than those named in the prior application. It is requested that the following inventor(s) identified above for the prior application be deleted.

II. Identification of Amendment Being Filed, Claims for Further Prosecution, and for Fee Change

WARNING: "The claims of a new application may be finally rejected in the first Office Action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds of art of record in the next Office Action if they had been entered in the earlier application." MPEP § 706.07(b).

☒ The claims for further prosecution and the fees to be charged are to be based on the number of claims remaining as a result of filing the:

_____ attached _____.

_____ the unentered amendment filed under 37 C.F.R. 1.116 in the prior application, which is now repeated.

☒ the claims as on file in the prior application.

III. Fee Calculation (37 C.F.R. 1.16)

Note: The filing fee for a continued prosecution application is based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under 37 C.F.R. 1.53(d) and entry of any amendments under 37 C.F.R. 1.116 unentered in the prior application which is requested to be entered in this CPA application. 37 C.F.R. 1.53 (d)(3).

CLAIMS FOR FEE CALCULATION

| | Number Filed | Number Extra | Rate Basic Fee | |
|---|--------------|--------------|-------------------|-------------------------------|
| | | | | 37 C.F.R. 1.16(a) \$750.00 |
| Total Claims (37 C.F.R. 1.116(c)) | 12 - 20 = 0 | 0 | \$18.00 | \$ |
| Independent Claims(37 C.F.R. 1.16(b)) | 1 - 3 = 0 | x | \$84.00 | |
| Multiple dependent claim(s), if any (37 C.F.R.1.16(d)) | | + | \$280.00 | |

Filing fee Calculation

\$750.00

_____ The fee for extra claims is not being paid at this time.

NOTE: *If the fees for extra claims are not paid on filing they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. 1.16(m).*

IV. Small Entity Statement

_____ A statement that this is a filing by a small entity is attached.

WARNING

"Status as a small entity in one application or patent *not* affect any other application or patent, including applications and patents which are directly or indirectly dependent upon the application or patent in which the status has been established. A nonprovisional application claiming the benefit under 35 U.S.C. 119(e), 120, 121 or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to a verified statement in the prior application or includes a copy of the verified statement filed in the prior application if status as a small entity is still proper and desired." 37 C.F.R. 1.28(a).

(complete the following, if applicable)

___ Status as a small entity was claimed in prior application no _____
filed on _____, from which benefit is being claimed for this
application under:

35 U.S.C. ___ 120,
 ___ 121,
 ___ 365 (c)

and which status as a small entity is still proper and desired.

___ A copy of the verified statement in the prior application is included.

Reduced filing fee calculation (50% of above) \$ _____

NOTE: See 37 C.F.R. 1.28(e).

Any excess of the full fee paid will be refunded if a statement and a refund request are filed within 2 months of the date of timely payment of a full fee then the excess fee paid will be refunded on request. 37 C.F.R. 1.28(e).

V. Fee Payment Being Made at This TimeNot attached

___ No filing fee is submitted.
(This and the surcharge required by 37 C.F.R. 1.16(e) can be paid subsequently.)

Attached

| | | |
|--------------|---|-----------|
| <u> X </u> | filing fee | \$ 750.00 |
| ___ | recording assignment (\$40.00 37 C.F.R. 1.21(h)). | \$ |
| ___ | petition fee for filing by other than all the inventors or person not the inventor where inventor refused to sign or cannot be reached (\$130.00; 37 C.F.R. 1.47 and 1.17(i)). | \$ |
| ___ | processing and retention fee (\$130.00; 37 C.F.R. 1.53(f) and 1.21(l)). | \$ |

NOTE: 37 C.F.R. 1.21(l) establishes a fee for processing and retaining any application that is abandoned for failing to complete the application pursuant to 37 C.F.R. 1.53(f) and this, as well as the changes to 37 C.F.R. 1.53 and 1.78, indicate that in order to obtain the benefit of a prior U.S. application, either the basic filing fee must be timely paid or the processing and retention fee in §1.21(l) must be paid within 1 year from the notification under § 1.53(f).

Total fees enclosed \$ 750.00

VI. Method of Payment of Fees

☒ Attached is check in the amount of \$ 750.00.

☐ Charge Account No. _____ in the amount of \$ _____.

☐ A duplicate of this request is attached.

VII. Authorization to Charge Additional Fees

WARNING: If no fee payment is made at this time, this item should not be completed.

WARNING: Accurately count claims, especially multiple dependent claims, to avoid unexpectedly high charges if extra claim charges are authorized.

The Commission is hereby authorized to charge the following additional fees that may be required by this paper and during the entire pendency of this application to Account No. 05-0461.

☒ 37 C.F.R. 1.16(a), (f) or (g) (filing fees)

☐ 37 C.F.R. 1.16(b), (e) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or later on presentation must only be paid or these claims canceled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

☐ 37 C.F.R. 1.16(a) (surcharge for filing the basic filing fee and/or declaration on a data later than the filing date of the application)

☐ 37 C.F.R. 117 (application processing fees)

WARNING: 37 C.F.R. 1.17 (a) deals with extensions of time under § 1.136(a).

☒ A separate petition to extend time accompanies this application with the appropriate extension fee under 1.17(a).

☐ A separate request accompanied this application authorizing the Office to treat each reply as incorporating a petition to extend time, 37 C.F.R. 1.136(a)(3).

VIII. Priority--35 U.S.C. §119(a)-(d)

____ Priority of Application No. _____ filed on _____, in _____
is claimed under 35 U.S.C. 119.

____ The certified copy has been filed on _____ in prior U.S.
application Serial No. _____, which prior application was filed on _____.

____ Certified copy will follow,

IX. Relate Back

WARNING:

If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). 35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b.)

NOTE: *The request for a continued prosecution application under 37 C.F.R. 1.53 (d) is the specific reference required by 35 U.S.C. 120 to the prior application. The identification of an application by application number under 37 C.F. R. 1.78 (a)(2) is the specific reference required by 35 U. S. C. 120 to every application assigned that application number. Cross-references to other related applications may be made when appropriate. (See § 1.14(a)). 37 C.F.R. §1.78(a)(2).*

(complete the following, if applicable)

35 U.S.C. 119(e) For Prior Provisional Applications

NOTE: *"Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of the series code and serial number)." 37 C.F.R. 1.78(a)(4).*

WARNING: *While this application under 37 C.F.R. 1.53 (d) cannot be a continuation prosecution application of a provisional application, the nonprovisional application giving rise to this CPA filing could claim the benefit of a provisional application.*

____ Amend the specification by inserting, before the first line, the sentence:

"This application claims the benefit of U.S. Provisional Application(s) No(s):

APPLICATION NO(S):

FILING DATE

X. Assignment

 X The prior application is assigned of record to: United States Gypsum Company.

____ An assignment of the invention to _____ is attached. A separate ____ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ____ FORM PTO 1595 is also attached.

NOTE:

"If an assignment is submitted with a new application, send two separate letters - one for the application and one for the assignment." Notice of May 4, 1990 (1114 O.G. 77-78).

XI. Power of Attorney

The power of attorney in the prior application is to:

Donald E. Egan
Attorney

19,691
Registration Number

- a. ☐ The power appears in the original papers in the prior application.
- b. ☐ The power does not appear in the original papers, but was filed on _____.
- c. ☐ A new power has been executed and is attached.
- d. ☒ Address all future communication to:

Donald E. Egan
Registration No. 19,691
273 Stonegate Road
Clarendon Hills, IL 60514
(630) 920-8440

XII. Maintenance of Copendency of Prior Application

(this item must be completed and the necessary papers filed in the prior application, if the period set in the prior application has run)

- ☐ A petition, fee and response have been filed to extend the term in the pending prior application until _____.

Note

The Patent and Trademark Office finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the ((continued prosecution application), Notice of Nov. 5, 1985 (1060 O. G. 27).

- ☐ A copy of the petition for extension of time in the prior application is attached,

XIII. Conditional Petitions for Extension of Time in Prior Application

(complete this item and file conditional petition in prior application, if previous item is not applicable)

- ☐ A conditional petition for extension of time is being filed in the pending prior application.

NOTE:

The Patent and Trademark Office finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the ((continued prosecution application), Notice of Nov. 5, 1985 (1060 O. G. 27),

- A copy of the conditional petition for extension of time in the prior application is attached.

XIV. Abandonment of Prior Application

X Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application copending with said prior application. At the same time, please add the words 'now abandoned' to the amendment to the specification set for in IX, above.

NOTE: According to the Notice of May 13, 1983 (103 TMOG 6-71), the filing of a (continued prosecution application) is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

NOTE: A registered attorney or agent acting under the provisions of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing dated granted to a continuing application when filing such a continuation application..." 37 C.F.R. 1.138.

XV. Information Disclosure Statement

Submitted herewith is an Information Disclosure Statement.

X Please enter and consider all references in the parent and prior applications, for this continued prosecution application.

Respectfully submitted,



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(630) 920-8440

March 14, 2003